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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of:

Confirmation No.: 5212

Andrew E. MYERS et al.

Group Art Unit: 2645

Serial No.: 10/041,571

Examiner: Ovidio Escalante

Filed: January 10, 2002

Title: SYSTEM AND METHOD FOR ANNOTATING VOICE MESSAGES

REPLY BRIEF

Mail Stop Appeal Brief-Patents
The Assistant Commissioner for Patents
P.O. Box 1450
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Sir:

I. INTRODUCTION

This Reply Brief is being filed within two months of the Examiner's Answer dated December 1, 2004. This Brief responds to the new points raised by the Examiner's Answer.

A. The Status of the Claims

Claims 1-23 are pending in the application. Claims 1-23 stand rejected under 35 U.S.C. §103(a) as being obvious over Wilcox et al. (U.S. patent No. 6,404,856) in view of Becker et al. (Publication No. US 2002/0130904 A1).

II. GROUND OF REJECTION

Independent claims 1, 7, 12, and 18 recite, among other things, "a message forwarder that enables forwarding of audible messages, wherein the annotations associated with the audible

messages are forwarded at the option of the subscriber.” The Examiner acknowledges that “Wilcox does not specifically teach a message forwarder that enables forwarding of audible messages and annotations at the option of the subscriber,” (see the last full paragraph on page 3 of the December 1, 2004 Examiner’s Answer). The Examiner alleges that “Becker teaches that it is well known in the art to have a message forwarder that enables forwarding of *audible* messages (paragraph 0047 and 0089) to other recipients and wherein annotations are forwarded at the option of the subscriber, (paragraphs 0051 and 0056),” (emphasis added, see the last paragraph on page 3 bridging onto page 4 of the December 1, 2004 Examiner’s Answer). While paragraphs 0047 and 0089 appear to disclose audible messages, they do not disclose annotating the audible messages. Furthermore, while paragraph 0051 appears to disclose enabling a user to respond back to the initiating user, this paragraph is directed to communicating through an instant messaging session and does not support the Examiner’s suggestion of annotating the audible message. Similarly, paragraph 0056 appears to disclose enabling a user to communicate through a text messaging session and does not support the Examiner’s suggestion of annotating the audible message. Thus, the Examiner appears to have mischaracterized and misapplied the teachings and/or suggestions of Becker.

III. RESPONSE TO EXAMINER’S ARGUMENTS

A. Wilcox Does Not Suggest a Message Forwarder

The Examiner refers to column 6, lines 47-53 of Wilcox to provide a suggestion of a message forwarder (see paragraph number 1 on page 6 of the Examiner’s Answer). The relied upon passage appears to describe an option of playing back segments of audio data files to both parties of a conversation during the conversation, thus enabling comments from previous conversations to be shared. Playing back segments of audio data files to both parties of a conversation during the conversation is not analogous to the claimed message forwarder.

At best, Wilcox appears to disclose enabling an audible message to be replayed during a telephone conversation. Even if replaying of an audible message during a telephone conversation could be considered forwarding of a message, and Appellant’s assert that it cannot, it appears that, at most, audible information would be forwarded. “Forwarding” of audible

information during a telephone conversation is not the same as forwarding of an actual data file having an audible message with or without annotations. *See Specification at page 5, lines 13-16; page 7, lines 16-19.* Thus, without a suggestion of forwarding in Wilcox, there is no motivation to combine features of Wilcox and Becker.

B. Examiner's Assertions that the Appellant's Previous Statements are Contradictory are False

The Examiner alleges that statements provided by Appellant's in the Appeal Brief are contradictory. Specifically, the Examiner asserts that the Appellant's statement that "the Examiner has not provided any support that Becker discloses a message forwarder that enables forwarding of *audible* messages and annotations" (emphasis added) contradicts with Appellant's statement that "Becker discloses the decision to annotate or not to annotate the entire messaging session is made at the time the entire messaging session is to be forwarded." However, these statements are separate and distinct, and are not contradictory.

Appellant's claim recites a message forwarder that enables forwarding of *audible messages and annotation*. As Appellant states in the Appeal Brief and clarifies in the Grounds of Rejection section presented above, Becker does not teach or suggest forwarding of *audible messages and annotation*.

Appellant's second statement above that is relied on by the Examiner is in reference to the apparent teachings of Becker as clarified in the Grounds of Rejection section presented above. While Becker may disclose annotating an entire message session at the time of forwarding, Becker describes only the forwarding of text messages with annotations, not forwarding *audible* messages and annotations. Thus, Appellant's statements are clearly not contradictory. One statement refers to Becker's lack of disclosing forwarding audible messages with annotations, while the other statement refers to the apparent teaching by Becker of possibly annotating a set of text messaging sessions.

The option to forward annotations to a set of text message sessions (i.e., non-audible message) as taught by Becker is not the same as the Appellant's claimed feature of forwarding annotations associated with an *audible* message. The Examiner has repeatedly failed to address

this distinction. While Becker may describe the ability to receive messages of multiple types, including audio, Becker does not disclose annotating an audio message with text and optionally forwarding both the audio message and the text annotation.

C. The Combination of Becker and Wilcox Do Not Teach or Suggest a Message Forwarder for Forwarding Audible Messages and Optionally Forwarding the Associated Annotations

The Examiner alleges in the Examiner's Answer that Appellant has not made arguments as to whether or not Wilcox teaches annotating a message during playback and only relies on Becker for this feature.


As presented above, Wilcox does not support the Examiner's position that "Wilcox at least suggests of a 'message forwarder' for forwarding the message" (see paragraph number 1 on page 6 of the Examiner's Answer). Thus, the Examiner's alleged motivation for combining Wilcox and Becker based on the suggestion of a message forwarder in Wilcox finds no basis in Wilcox. Since Wilcox fails to teach or suggest a message forwarder, it is irrelevant under the 103 rejection whether or not Wilcox teaches annotating a message during playback.

Appellants now appeal to this Honorable Board to promptly reverse these rejections and issue a decision in favor of Appellants. All of the claims are in condition for allowance.

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Respectfully submitted,

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